

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111

Serial Number: 09/237,219

Filing Date: January 25, 1999

Title: SYSTEM, METHOD, AND SOFTWARE FOR INSERTING HYPERLINKS INTO DOCUMENTS

Page 8

Dkt: 962.002 US1

Reservation of Rights

Applicant reserves all applicable rights not expressly exercised in connection with this response, including, for example, the right to swear behind one or more cited references and the right to rebut characterizations of the references and asserted combinations or motives for combination. Applicant makes no admissions regarding the prior art status of any of the cited art.

Interview Summary

Applicant acknowledges the courtesy of Examiners Feild and Nyugen in granting an interview with applicant's patent counsel Eduardo Drake on January 8, 2003. During the interview, Sotomayor (U.S. Patent) was discussed relative to several of the claims. It was agreed that claims 14 and its dependents (which concern the use of user preferences to define hyperlinks) and claims 21-26 and 46-49 (which concern the inclusion of search commands, such as query connectors and search-method identifiers, in hyperlinks) were allowable over the Sotomayor patent. However, the Examiners indicated that ultimate allowability was contingent on any findings from further searching.

The Examiner's also indicated during the interview that they had recently become aware U.S. Patent 6,266,539, which at least superficially appeared relevant to some claims in the application. Accordingly, applicant submits herewith a copy of the noted patent.

Response to §102 Rejections

Claims 1-9, 14, 15, 17 and 19-49 were rejected under 35 USC §102(e) as anticipated by Sotomayor (U.S. Patent 5,708,825.) Applicant traverses the rejection respectfully as follows.

Claims 1-9, 17, 19, and 39-49 have been amended to more readily distinguish from Sotomayor. For example, these claims now require "generating one or more hyperlinks, with each hyperlink including at least a portion of ... one or more of the marked portions [of the documents] and identifying a computerized service for use in conducting a search based on the included portion of the content.

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111

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Page 9

Dkt: 962.002US1

Applicant found nothing in Sotomayor that appears to correspond to this requirement.

Sotomayor appears to define its hyperlinks, at column 1, line 66 - column 2, line 19, as including:

- (a) hyperlink source 72, which specifies a key topic to be displayed in a hot area. A 'hot area' is a portion of the display screen that, if pointed at and clicked on, will cause the computer to execute computer code such as a hyperlink program 79 which hyperlinks (i.e., causes a branch) to a hyperlink destination 74. ...
- (b) hyperlink destination 74, which includes information, (e.g., destination location specification 73) specifying the location of the text or picture that will be displayed if the hyperlink is taken. ...
- (c) hyperlink computer code 79 that, in response to a 'viewer action', causes hyperlink destination 74 to be displayed in the context in which it appears.

Accordingly, it does not appear that one of skill would regard Sotomayor as meeting all the requirements of claims 1-9, 17,19, 22, 25-28, and 39-49.

Claims 14, 21, 23, and 46-49, as noted in the above Interview Summary, were agreed to distinguish over Sotomayor based their recitation of "user preferences..". In view of this agreement, applicant presents no further remarks regarding these claims in this paper, except to note that claims 14 and several of its dependents have been amended to omit the phrase "providing user preferences," and that claims 21 and 23 have been rewritten in independent form. These amended claims are still believed to distinguish from Sotomayor based on the remaining requirements related to "uscr preferences."

Accordingly, applicant requests respectfully that the §102 rejection of these claims be withdrawn.

New Claims 50-61

New claims 50-61 are believed to also distinguish from Sotomayor. For example, these claims require an act of or means for "generating one or more hyperlinks, with each hyperlink ... having a URL which includes at least a portion of one of the marked portions [of the document]."'

Nothing in Sotomayor appears to meet this requirement. See, for example, column 10, lines 50- column 11, line 12, which states:

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111

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Filing Date: January 25, 1999

Title: SYSTEM, METHOD, AND SOFTWARE FOR INSERTING HYPERLINKS INTO DOCUMENTS

Page 10

Dkt: 962.002US1

If the text in which one wanted to embed a hyperlink is, "One should identify the essence of the idea if one wants to think clearly."..., and the key topic term is "the essence", then in order to insert a combination anchor 67 comprising a destination anchor 76 and a source anchor 75, summary page generator 40 changes the text to be:

One should identify [A NAME = "DEF34876"]
 the essence of the idea if one
wants to think clearly.

The above is a typical HTML format ... The phrase NAME="DEF34876" defines the name of the destination anchor 76 within the document in order that a hyperlink to the destination can find the destination. The phrase HREF="#GEN03789" provides the destination location specification 73 used as a destination reference name which the web browser will hyperlink to if the highlighted area is clicked on or otherwise activated. Here "DEF34876" and "GEN03789" are arbitrary generated names Where a hyperlink is to another document, the name of that document precedes the "#", so for example the hyperlink:

Href = "http://www.myserver.com/user1/project2#GEN03789" would hyperlink to the label name GEN03789 in the document user1/project2 at the server computer at the network address Href="http://www.myserver.com/user1/project2#GEN03789" would hyperlink to the label name GEN03789 in the document user1/project2 at the server computer at the network address http://www.myserver.com.

In this example, the URL "http://www.myserver.com/user1/project2#GEN03789" lacks any portion of phrase "the essence," which Sotomayor appears to mark in the document.

Accordingly, it does not appear that one of ordinary skill would regard Sotomayor as meeting all the requirements of the new claims.

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111

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Page 11
Dkt: 962.002US1

Conclusion

In view of the amended claims and highlighted deficiencies of the cited art, applicant respectfully requests reconsideration of the application. Moreover, applicant requests that the Examiner initiate a telephone interview with its patent counsel Eduardo Drake, if she anticipates that the next communication will not be a Notice of Allowance.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being transmitted via facsimile to:
Commissioner of Patents, Washington, D.C. 20231, on this 21st day of January, 2003.

Anne M. Richards
Name

Signature

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